

REMARKS

Claims 1-10 and 12-20 are in the case. Claims 1-10, 12-17, and 19-20 are rejected under 35 USC § 103 over USPN 6,370,487 to Dorough in view of USPN 5,926,208 to Noonan et al., and further in view of USPN 5,845,166 to Fellegara et al., and further yet in view of USPN 7,308,158 to Herbert et al., and claim 18 is rejected under 35 USC § 103 over Dorough in view of Noonan et al. and further in view of Fellegara et al. and further yet in view of Herbert et al., and further still in view of USPN 6,512,858 to Lyon et al. The rejections are respectfully traversed. Reconsideration and allowance of the claims are respectfully requested.

EXAMINER'S "RESPONSE TO ARGUMENTS"

In the above-entitled section of the office action of 2008.10.31, the examiner makes some statements that the applicants would like to respond to.

First, the examiner states that "the applicants fail to provide an argument for why the prior art does not teach the limitations" Applicants assert that it is well-settled that an applicant does not need to provide an argument as to why the prior art does not teach any given limitation. Rather, it is the examiner's responsibility to explicitly point out where in the reference a given element of the invention as claimed is recited. Failing this, the examiner has not met his standard of proof. The applicant's only obligation is to provide arguments as to why a given point as asserted by the examiner might be in error.

Second, the examiner also states that Fellegara et al. teach that a "user may select from multiple cropping options," and references column 10 lines 31-39 in evidence of that assertion. Thus, the examiner is proffering his evidence of obviousness, which is appropriate. The applicants next explain why the examiner is in error as to this evidence.

The referenced portion of Fellegara et al. reads as follows:

30 At this point, the operator can initiate an exposure operation by activating the shutter button **24**. Alternatively, the operator may choose to change either the image format or the image capture mode by operating the image format selector switch **30** and the image capture mode selector
 35 switch **23** accordingly. If the image format mode is changed, the main camera controller **68** controls the viewfinder **20** to select the appropriate mask that corresponds to the selected image format setting corresponding to the new image format. The operator may also choose to use the zoom control

In this section, changes to both the “format” and the “capture mode” of the image are described. However, there is nothing in this portion that describes cropping a video stream to a variable degree in combination with the other elements as recited in claim 20. Both “format” and “capture mode” are described elsewhere in the reference, and neither contains any description of cropping a video stream to a variable degree and et seq. as claimed. Two of the “modes” are described as “a film mode image and a hybrid mode image[, which] are essentially cropped versions of the digital mode image with respectively different and equal resolutions.” However, this does not describe cropping a video stream to a variable degree in the manner as claimed. The examiner attempts to read far more into the reference than what is actually there, and thus – in response to the examiner’s final statement in this section of the office action – this is an improper reading of the reference.

Applicants note that it is permissible to give the claims their broadest reasonable meaning. However, it is not permissible to read things into the prior art that aren’t there. The prior art is to be interpreted for exactly what it says.

CLAIM REJECTIONS UNDER §103

Independent claim 1 claims, *inter alia*, a system for inspecting a substrate, with a sensor that produces a video stream, a control interface, a network to transport the video stream and the control stream, a desktop having a display to present the video stream and user interface controls to control operation of the inspector by use of the control stream, and a parser to selectively crop the video stream prior to delivery of the video stream to the desktop, where the selective cropping reduces a size of the video stream and produces

a cropped view and reduces a size of the video stream, and a *location* of the cropped view within a full video frame of the video stream *is remotely selectable* from the desktop via the control interface.

Applicants first compare the primary reference against the elements of the claim as recited above, to determine wherein the primary reference is deficient. Then the secondary references are analyzed to determine whether they compensate for the deficiencies detected in the primary reference. If all of the references are deficient as to the same element or combination of elements, then the claim is patentable over the cited references.

Dorough does not describe, among other things, the control interface, and the parser that selectively crops the video stream prior to delivery of the video stream to the desktop, where a location of the cropped view within a full video frame of the video stream is remotely selectable from the desktop via the control interface.

Noonen et al. do not compensate for the deficiencies of Dorough, in that Noonan et al. also do not describe cropping the video stream prior to delivering the video stream to the desktop, where the selective cropping reduces a size of the video stream, and a location of the cropped view within a full video frame of the video stream is remotely selectable from the desktop via the control interface.

Similarly, Fellegara et al. do not compensate for the deficiencies of Dorough and Noonan et al. in that Fellegara et al. also do not describe cropping the video stream prior to delivering the video stream to the desktop, where the selective cropping reduces a size of the video stream, and a location of the cropped view within a full video frame of the video stream is remotely selectable from the desktop via the control interface.

Finally, Herbert et al. do not compensate for the deficiencies of Dorough, Noonan et al., and Fellegara et al., in that Herbert et al. also do not describe cropping the video stream prior to delivering the video stream to the desktop, where the selective cropping reduces a size of the video stream, and a location of the cropped view within a full video frame of the video stream is remotely selectable from the desktop via the control interface. Column 7 of Herbert et al. describe remotely storing images and triggering images, but not controlling a video stream in the manner as indicated.

Thus, claim 1 patentably defines over Dorough in view of Noonen et al. and further in view of Fellegara et al. and further yet in view of Herbert et al. Reconsideration and allowance of claim 1 are respectfully requested.

Dependent claims 1-10 and 12-14 depend from independent claim 1, and contain additional important aspects of the invention. Therefore, dependent claims 1-10 and 12-14 patentably define over Dorough in view of Noonen et al. and further in view of Fellegara et al. and further yet in view of Herbert et al. Reconsideration and allowance of dependent claims 1-10 and 12-14 are respectfully requested.

Independent claim 15 claims, *inter alia*, a system for inspecting a substrate, with an inspector having a sensor, a control interface, a network, a desktop for receiving the video stream and the control stream, a display and user interface controls to control operation of the inspector across the network, a compressor to selectively compress the video stream, a decimator to selectively down sample the video stream, a parser adapted to selectively crop the video stream prior to delivery of the video stream from the sensor to the desktop, where the selective cropping produces a cropped view and reduces a size of the video stream, and a *location* of the cropped view within a full video frame of the video stream *is remotely selectable* from the desktop via the control interface, and a codec to selectively set a frame rate of the video stream, where the selective cropping reduces a size of the video stream.

Thus, claim 15 also claims the parser that selectively crops the video stream prior to delivery of the video stream to the desktop, where a location of the cropped view within a full video frame of the video stream is remotely selectable from the desktop via the control interface, which the combination of Dorough, Noonen et al., Fellegara et al., and Herbert et al. do not describe.

Therefore, claim 15 patentably defines over Dorough in view of Noonen et al. and further in view of Fellegara et al. and further yet in view of Herbert et al. Reconsideration and allowance of claim 15 are respectfully requested. Dependent claims 16-17 and 19 depend from independent claim 15, and contain additional important aspects of the invention. Therefore, dependent claims 16-17 and 19 patentably define over Dorough in view of Noonen et al. and further in view of Fellegara et al. and further

yet in view of Herbert et al. Reconsideration and allowance of dependent claims 16-17 and 19 are respectfully requested.

Independent claim 20 claims, *inter alia*, a system for inspecting a substrate, with an inspector having a sensor, a control interface, a network, a desktop for receiving the video stream and the control stream, a display and user interface controls to control operation of the inspector across the network, a compressor to selectively compress the video stream to a variable degree, a decimator to selectively down sample the video stream to a variable degree, a parser ***to selectively crop the video stream to a variable degree*** as specified through the user interface controls on the desktop, where the selective cropping reduces a size of the video stream, and a frame grabber to selectively set a frame rate of the video stream to a variable degree, where the compressor, decimator, parser, and frame grabber all reside within the inspector.

None of the four cited references describe selectively cropping the video stream ***to a variable degree*** as specified through the user interface controls on the desktop. Therefore, claim 20 patentably defines over Dorrough in view of Noonan et al. and further in view of Fellegara et al. and further yet in view of Herbert et al. Reconsideration and allowance of claim 20 are respectfully requested.

Claim 18 is rejected over Dorrough in view of Noonan et al. and further in view of Fellegara et al., and further yet in view of Herbert et al., and further still in view of Lyon et al. Dependent claim 18 depends from independent claim 15, and therefore claims *inter alia*, a system for inspecting a substrate, with an inspector having a sensor, a control interface, a network, a desktop for receiving the video stream and the control stream, a display and user interface controls to control operation of the inspector across the network, a compressor to selectively compress the video stream, a decimator to selectively down sample the video stream, a parser adapted to selectively crop the video stream prior to delivery of the video stream from the sensor to the desktop, where the selective cropping produces a cropped view and reduces a size of the video stream, and a ***location*** of the cropped view within a full video frame of the video stream ***is remotely selectable*** from the desktop via the control interface, and a codec to selectively set a frame rate of the video stream, where the decimator and the parser operate cooperatively to selectively down sample the video stream to a lesser degree when the video stream is

selectively cropped to a higher degree, and to selectively down sample the video stream to a higher degree when the video stream is selectively cropped to a lesser degree.

Thus, claim 18 also claims the parser that selectively crops the video stream prior to delivery of the video stream to the desktop, where a location of the cropped view within a full video frame of the video stream is remotely selectable from the desktop via the control interface, which the combination of Dorough, Noonan et al., Fellegara et al., and Herbert et al. do not describe.

Lyon et al. do not remedy this deficiency, in that Lyon et al. also do not describe the parser that selectively crops the video stream prior to delivery of the video stream to the desktop, where a location of the cropped view within a full video frame of the video stream is remotely selectable from the desktop via the control interface. Lyon et al. describe decimating an image (skipping rows of pixels) and displaying portions of an image on a lower resolution display. Neither of these things are considered in the art to be cropping, and they do not reduce a video stream size (they merely limit what of the video stream is displayed). In fact, Lyon et al. never use the word “crop,” or describe any action that reads on cropping, which is a well-defined term in the art.

Further, none of the references – either alone or in combination – describe the inverse relationship and selective balancing between the down sampling and cropping functions of the inspector, as claimed in claim 18.

Therefore, claim 18 patentably defines over Dorough in view of Noonan et al. and further in view of Fellegara et al. and further yet in view of Herbert et al. and further still in view of Lyon et al. Reconsideration and allowance of claim 18 are respectfully requested.

COMBINATION OF REFERENCES

The present claims recite certain elements in combination. Applicants do not at this time assert that any one of these elements, taken alone, is completely novel. However, “[c]ombination claims can consist of new combinations of old elements . . . for it may be that the combination of the old elements is novel and patentable.” *Clearstream Wastewater Sys. v. Hydro-Action, Inc.*, 206 F.3d 1440, 1444, 54 USPQ2d 1185, 1189 (Fed. Cir. 2000); *Intel Corp. v. U.S. Int’l Trade Comm.*, 946 F.2d 821, 842, 20 USPQ2d

1161, 1179 (Fed. Cir. 1991) (“That all elements of an invention may have been old . . . is however, simply irrelevant. Virtually all inventions are combinations and virtually all are combinations of old elements.”).

Thus, it might be possible to find each and every element somewhere in the prior art. The examiner appears to have done this by stringing together an ever-increasing number of references, where each reference is used to add one or two more of the elements of the claim into the mix. However, none of the references describe a system of the general type as that which is claimed. The examiner is chopping up the apparatuses of the cited references and putting them back together again to form a facsimile of the present invention as claimed without any motivation to make the combinations such as are described in the claims – save the motivation to create something that looks like the system as claimed.

However, the motivation to combine references cannot come from the invention itself. *See In re Oetiker*, 24 U.S.P.Q.2D 1443, 1446. The claims of the present application appear to have been used as a frame, and individual parts of separate prior art references were employed to recreate a facsimile of the claimed invention. *See W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 U.S.P.Q. 303, 312. That is impermissible.

It makes no difference that some benefit can be identified for a given combination – a benefit can be identified for (probably) every combination of elements under the sun, but that wouldn’t make every combination obvious (or no more patents would ever be granted).

CONCLUSION

Applicants assert that the claims of the present application patentably define over the prior art made of record and not relied upon for the same reasons as given above. Applicants respectfully submit that a full and complete response to the office action is provided herein, and that the application is now fully in condition for allowance. Action in accordance therewith is respectfully requested.

In the event this response is not timely filed, applicants hereby petition for the appropriate extension of time. If any fees are required by this response, such fees may be charged to deposit account 12-2355.

Sincerely,

LUEDEKA, NEELY & GRAHAM, P.C.

By: 

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